

REMARKS

Claims 1-20 are pending.

No amendments have been made to the claims. It is respectfully submitted that, on the basis of the following remarks, the Examiner's new grounds of rejection have been addressed and overcome, and that the present Application is in condition for the issuance of a Notice of Allowance.

Claims 1, 2, 4, 7-13 and 16-19: Rejected Under 35 U.S.C. § 103(a)

The Examiner rejects Claims 1, 2, 4, 7-13 and 16-19 under 35 U.S.C. § 103(a) on the ground of being unpatentable over U.S. Patent No. 6,992,699 (Vance et al.) and further in view of U.S. Pub. No. 2003/0122957 (Emme).

Claim 1 recites, *inter alia*, a ***compartment door*** structured to be used with a handheld electronic device of a type having a primary housing portion with a cavity formed therein and having a battery disposed on the primary housing portion and being ***disposed in the cavity***. The cavity is in communication with an exterior of the primary housing portion. The compartment door comprises: a panel having an inner surface and an outer surface; a camera mounted to the panel and disposed substantially opposite the outer surface; a number of attachment structures disposed on the panel and structured to cooperate with the handheld electronic device to mount the compartment door to the handheld electronic device to substantially enclose the cavity. The ***compartment door is structured to cooperate with the primary housing portion to together form a housing*** of the handheld electronic device, with the inner surface of the panel facing toward the cavity, with the ***camera being disposed substantially within the cavity***, and with the outer surface facing away from the cavity when the compartment door is mounted to the handheld electronic device. The compartment door is structured to be ***removable from the primary housing portion and from the battery*** disposed on the primary housing portion. The exterior of the primary housing portion includes an exterior surface, and the ***cavity is formed in the exterior surface***. Bold and italicized words herein identify distinctions of the claimed invention, which are not taught or suggested by the cited references.

The Examiner admits (page 5, first full paragraph of the Office Action) that Vance et al. fails to make any disclosure or suggestion of the exterior of the primary housing portion including an exterior surface, wherein the cavity is formed in the exterior surface, as claimed, but the Examiner asserts that one of ordinary skill in the art would have been "motivated to incorporate the teachings of Emme with the

teachings of Vance et al. to have a cover that can be easily removed from the primary housing portion.” Applicants respectfully draw the Examiner’s attention to Figures 2 and 2a and the corresponding disclosure at paragraph 0036 of Emme, which teach the camera of that reference, the camera being “arranged at the rear of the mobile phone in the battery pack 11” (emphasis added). Underlined words herein identify teachings of the cited reference(s) that is/are contrary to the claimed invention. In other words, Emme clearly discloses a cell phone of the type wherein the battery itself serves as the exterior back portion of the cell phone. See also Exhibit 2 attached hereto, which is a printout from the website www.cellphoneshop.com showing the type of external battery disclosed in Emme. Such an external battery pack, wherein the battery pack itself forms part of the cell phone housing so as to avoid the use of a separate cavity for the battery and compartment door therefor, is in contrast to both Vance et al., which teaches front and back covers 42,44 of a housing 40 (column 3, line 7-25 and Figures 2 and 3 of Vance et al.), and to the compartment door of the claimed invention, which is structured to cooperate with a primary housing portion to together form a housing, and wherein a battery is disposed in a cavity enclosed by the compartment door, as claimed. See, for example, the separate battery 12, cavity 24, and compartment door 20 therefor of Figure 2 of the present Application.

As such, it cannot properly be said that the battery of Emme is a *compartment door*, as claimed. Furthermore, even assuming, arguendo, that the Emme battery could be somehow properly analogized to a compartment door, and Applicants maintain that it cannot be, then the battery would still fail to substantially enclose a cavity, wherein a battery and camera are disposed in the cavity, and wherein the compartment door is removable from the battery, as claimed. In any event, Emme, clearly teaches a cell phone, which instead of a separate battery, cavity, and compartment door (i.e., battery compartment door) therefor, uses the back surface of the battery itself as the exterior of the cell phone. In view of the foregoing, it is respectfully submitted that Emme adds nothing to Vance et al. to render Claim 1 obvious.

More specifically, Emme makes no teaching or suggestion of a *compartment door*, such compartment door being structured to be *removable from a battery*, as claimed. Rather, because it is the battery itself of Emme that serves as the exterior of the back of the cell phone housing, there is no compartment door and no housing formed by the compartment door together with the primary housing, as claimed. Emme also fails to disclose or suggest a *camera being disposed substantially*

within a cavity, as claimed. In fact, in direct contravention to both Vance et al. and the claimed invention, Emme teaches the camera being disposed “in the battery” (Figures 2 and 2a; and paragraph 0036 of Emme) (emphasis added).

Applicants further submit that Emme fails to disclose or suggest any cavity. Specifically, a “cavity” in accordance with the everyday ordinary meaning of that term, is a void or empty space between two surfaces. See Exhibit 1, which is a true and correct copy of the definition of “cavity” from the *Cambridge International Dictionary of English* at

<http://dictionary.cambridge.org/define.asp?key=12069&dict=CALD>, which defines “cavity” as, “a hole, or an *empty space between two surfaces*” (emphasis added).

Contrary to the Examiner’s assertions, the external battery and location on the exterior of the housing of Emme for attachment thereof cannot properly be said to form a cavity within this definition, and as claimed. Specifically, Emme teaches only one single surface (i.e., the surface of the primary housing portion) and an external battery attached thereto. As such, there are not *two surfaces* with an empty space (i.e., cavity) therebetween, wherein the battery is disposed in the cavity. Stated another way, one of ordinary skill in the art would find the external battery design of Emme, which is devoid of a cavity, a separate battery disposed within the cavity, and a compartment door to cover the cavity and the battery disposed therein, as claimed, to be contrary to the invention as well as to the internal battery (i.e., disposed between front and back covers 42,44 of housing 40) of Vance et al. Moreover, the camera of Emme is “in the battery pack 11” (paragraph 0036) (emphasis added), which is external (Figures 2 and 2a of Emme) and not disposed in a cavity and between two surfaces (i.e., the exterior surface of the primary housing and a panel of a compartment door), as claimed and as shown, for example, in Figure 2 of the instant Application. See also Exhibit 2, which is a true and correct copy from the website www.cellphoneshop.com showing external batteries of the type disclosed in Emme, which are clearly designed to attach directly to the exterior of the cell phone housing and to be exposed, without any cover (i.e., compartment door).

In view of the foregoing, it is submitted that to combine the closed housing 40 of Vance et al., wherein the relatively large mirror assembly 50 of the camera (Figure 4 of Vance et al.) and the internal battery (not shown) are disposed between the front and back covers 42,44 (column 3, lines 20-25 of Vance et al.) of the housing 40, with the external battery of Emme, wherein the camera is disposed in the external battery (Figures 2 and 2a, and paragraph 0036 of Emme), as suggested by the

Examiner, would require substantial reconstruction or redesign of the prior art references in violation of MPEP 2143.01(VI). *Id.* citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (an obviousness rejection is not appropriate if substantial reconstruction or redesign of the prior art references is necessary to arrive at the invention). Such combination would also render the cell phone of Vance et al. being modified unsatisfactory for its intended purpose in violation of MPEP 2143.01(V). See also *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (“If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”). Specifically, the enclosed housing 40 of Vance et al. and the components housed therein, such as the battery, camera and mirror assembly, cannot be arbitrarily cut and displaced to add an external battery having a camera, as taught by Emme.

Additionally, even assuming, arguendo, that the combination was somehow deemed to be appropriate, and Applicants maintain that it is not, such combination would still fail to teach or suggest the claimed invention. Specifically, providing Vance et al. with an external battery as taught by Emme (the camera being disposed in the battery as disclosed at paragraph 0036 of Emme) fails to teach or suggest a camera mounted on a panel of compartment door, wherein the compartment door is removable from the housing and a battery disposed in a cavity of the housing, as claimed.

Applicants further submit that Emme is non-enabling and, therefore, cannot properly be applied as a prior art reference. Specifically, no detail is supplied with respect to the Emme camera being “arranged at the rear of the mobile phone in the battery” (paragraph 0036 of Emme) (emphasis added). That is, as set forth in MPEP § 2121.01, “[t]he disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation.” *Id.*, citing *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). Here the reference merely states that there is a camera “in the battery.” The camera is not shown in any of the figures. Only a lens 36, which presumably covers the camera, is shown. As such, given the lack of detail in the Emme disclosure and figures, it is submitted that one skilled in the art could not reproduce such an external battery having a camera therein, without undue

experimentation. Accordingly, the Emme reference is not an enabling reference and cannot be used as the basis for a rejection under 35 U.S.C. § 103(a).

Even assuming, arguendo, that the combination of Emme with Vance et al. was somehow to be proper and Emme was an enabling reference that could properly be applied as prior art, which Applicants maintain is not the case, providing the Vance et al. phone housing with an external battery having a camera disposed therein would still fail to disclose or suggest a battery disposed in a cavity, the cavity having a compartment door, and the compartment door being removable from the battery, as claimed.

Further, with regard to the determination of obviousness under 35 U.S.C. § 103, the Supreme Court has recently stated that:

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, *it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.* This is so because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 2007 WL 1237837 (2007), (Slip Opinion at 14-15) (emphasis added). In addition, the Supreme Court also stated that:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, *this analysis should be made explicit.* See *In re Kahn*, 441 F.3d 977, 988 (Fed Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness*”).

Id., at ___ (Slip Opinion at 14) (emphasis added). The Supreme Court included an extended discussion reciting the nature of the inventions disclosed in the prior art and then several paragraphs identifying the rationale and reasons that the cited art could be combined and why one skilled in the art would make such a combination. *Id.*, at ___ (Slip Opinion at 3-6, 20-22).

With regard to combining known elements of an invention, the Supreme

Court further stated that, “[a] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.*, at ____ (Slip Opinion at 14). This holding comports with *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) which held that, although some of the cited references, individually, may have some of the claimed inventions’ features, “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.” *Id.* at 1075. Instead, to reach the proper conclusion under §103:

the decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether...the claimed invention as a whole would have been obvious at *that* time to *that* person.

Id. at 1073-74.

In the instant case, it is respectfully submitted that the Examiner has not properly supported the rejection under 35 U.S.C. § 103(a) and under *KSR International*. Rather, the Examiner has merely identified selected elements from the cited art, and stated that, “one of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of Emme with the teachings of Vance et al. to have a cover that can be easily removed from the primary housing portion ...” September 17, 2007 Office Action at pages 5 and 6. This sentence is the only statement regarding the motivation to combine the references. Therefore, it is submitted that the Examiner has not “made explicit” the reason such references would, or could, be combined as suggested. For example, the Examiner has not explained why one skilled in the art would combine the external battery with a camera therein of Emme with the enclosed battery and mirror assembly of Vance et al. For example, the mirror assembly 50 of Vance et al. is operated (i.e. rotated) by a ring 64 protruding from the housing 40 (column 3, lines 35-47 and Figures 2-4 of Vance et al.). There is no reason for one of skill in the art to render this key aspect of the invention of Vance et al. inoperative by cutting the housing 40 and attaching an external battery and camera to the exterior of the housing 40 as taught by Emme. Doing so would result in the camera being disconnected with respect to the mirror, rendering the modified cell phone of Vance et al. unfit for its intended purpose.

It is respectfully submitted that merely identifying specific elements that various references disclose and stating that they may be combined is not an “articulated reasoning with some rational underpinnings” sufficient to support the conclusion of

obviousness. In fact, the single sentence provided by the Examiner is a “mere conclusory statement” that cannot properly support a rejection under 35 U.S.C. § 103. As set forth by the Court in *KSR International*, a “patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” Furthermore, as previously discussed, to combine the references as suggested by the Examiner in the instant case would render the reference being modified unfit for its intended purpose. Applicants, therefore, believe that the Examiner’s single conclusory sentence is not sufficient to qualify as an “articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness” and that the Examiner has, therefore, failed to make the analysis explicit in accordance with *KSR International*.

In view of the foregoing, it is submitted that Claim 1 is patentably distinguishable over the cited references.

Claims 2, 4 and 7-9 depend directly or indirectly from Claim 1 and, therefore, are also patentable over the cited references at least on the basis of such dependency.

Claim 2 is further patentably distinguishable over the references for the following reasons. Specifically, contrary to the Examiner’s assertions at page 6 of the Office Action, the outer surface of item 38 in Figure 4 of Vance et al. would not be aligned with the exterior surface of the handheld electronic device because item 38 is a printed circuit board (column 3, lines 59-62 of Vance et al.). The outer surface of the printed circuit board 38 would, at best, abut the inner surface of the back cover 44 of the housing. Thus, not only is the printed circuit board 38 not a panel of a compartment door, it is also not disposed substantially *flush* with the exterior surface of the primary housing adjacent the cavity, as claimed.

Claim 4 is further patentably distinguishable because the back cover 44 of housing 40 of Vance et al. cannot properly be said to be a battery compartment door to enclose a battery, as claimed. Removing the back cover would expose all of the internals of the handheld electronic device, not just a battery compartment. With regard to Claims 7, 8 and 9, it is respectfully submitted that the Examiner has improperly analogized the printed circuit board 38 of Vance et al. to the claimed *compartment door*, which is clearly an entirely different and unrelated structure.

Claim 10 is another independent claim which is patentable over the references for substantially the same reasons as those discussed hereinabove with respect to Claim 1.

Claims 11-13 and 16-19 depend directly or indirectly from Claim 10 and, therefore, are also patentable over the cited references at least on the basis of such dependency.

Claim 11 is further patentably distinguishable over the references for reasons similar to those previously discussed with respect to Claim 2. Claim 13 is further patentably distinguishable for reasons similar to those previously discussed with respect to Claim 4.

With regard to Claims 16, 17, 18 and 19 it is respectfully submitted that the Examiner has improperly analogized the printed circuit board 38 of Vance et al. to the claimed *compartment door*, which is clearly an entirely different and unrelated structure.

Claims 3 and 20: Rejected Under 35 U.S.C. § 103(a)

The Examiner rejects Claims 3 and 20 Under 35 U.S.C. § 103(a) on the ground of being unpatentable over Vance et al. in view of Emme, and in further view of U.S. Patent No. 6,660,427 (Hukill et al.).

Vance et al. and Emme have been discussed hereinabove. Hukill et al., which discloses a latching assembly for a battery door of a portable electronic device, wherein the latching assembly includes an encapsulated biasing spring and snapping catches (Abstract; and Figures 1 and 9-12 of Hukill et al.), adds nothing to Vance et al. and/or Emme to render the claimed invention obvious.

Claims 3 and 20 depend from Claims 1 and 10, respectively, and therefore, are also patentably distinguishable over the references at least on the basis of such dependency.

Claims 5-6 and 14-15: Rejected Under 35 U.S.C. § 103(a)

The Examiner rejects Claims 5-6 and 14-15 under 35 U.S.C. § 103(a) on the ground of being unpatentable over Vance et al. in view of Emme, and in further view of U.S. Patent No. 6,616,277 (Davenport).

Vance et al. and Emme have been discussed hereinabove. Davenport, which discloses a sequential eye screening method and apparatus (Title, Abstract and Figures 1, 2 and 5-17 of Davenport), adds nothing to Vance et al. and/or Emme to render the claimed invention obvious.

Claims 5-6 and 14-16 depend from Claims 1 and 10, respectively, and therefore are also patentably distinguishable over the references at least on the basis of

such dependency.

Furthermore, Applicants submit that an eye screening apparatus is entirely unrelated and non-analogous with respect to a cell phone, and the problem to be solved (eye recognition) of Davenport is also entirely different and unrelated to the LEDs for the camera of the claimed invention. One of skill in the art would not have been prompted to look to an eye recognition method and apparatus for reference as to how to mount a digital camera and light source therefor on a removable battery compartment door of a cell phone, as contemplated by the claimed invention. As such, it is respectfully submitted that the combination of Davenport with Vance et al. and Emme is not proper for purposes of an obviousness determination under Section 103(a).

CONCLUSION

The prior art made of record and not relied upon, but considered pertinent to Applicant's disclosure, has been reviewed and is deemed not to provide any additional relevant teaching. In summary, it is submitted that Claims 1-20 are patentable over the references of record.

Reconsideration and early allowance are requested.

Respectfully submitted,

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